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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/160,581	09/25/1998	RYUICHI ISHIKAWA	0041-0619-3	6525

22850 7590 01/27/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

CHANG, RICK KILTAE

ART UNIT

PAPER NUMBER

3729

DATE MAILED: 01/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Dg

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/160,581	ISHIKAWA ET AL.
	Examiner	Art Unit
	Rick K. Chang	3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 06 December 2002.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 5-16 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 5-16 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 5-16 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. It is not possible for the blade to move in negative speeds. It is unclear whether the blade travel direction for cutting the optical fiber occurs during negative blade speed. It is not possible for the blade to have negative blade thickness to derive positive speeds. In re Cortright, 49 USPQ2d 1464 (Fed. Cir. 1999); In re Gottlieb, 140 USPQ 665 (CCPA 1964); and In re Citron, 138 USPQ 516 (CCPA 1963).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 5-16 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for moving a cutting blade greater than 0 mm/minute, does not reasonably provide enablement for moving the blade at a speed less than 0 mm/minute. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Speed is an absolute value.

5. Claims 5-16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as originally filed, fails to provide support for “ $\beta \leq -253\alpha + 65$ , and when the speed  $\beta$  is positive, the cutting blade moves in a direction for cutting optical fiber”.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 5-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5 and 11: the expression  $\beta \leq -253\alpha + 65$  renders the claim vague and indefinite. It is unclear how a blade can travel in negative speed and have a thickness to meet the expression. The speed takes into account only the distance traveled; it does not take into account the direction of travel. Speed is always a positive number (absolute value). If it is a negative number, the blade will travel back in time. This expression violates every known physical law. Further, it is inconceivable that a blade having a thickness of less than  $65/253$  (0.257) mm to cut an optical cable. Does the blade travel direction for cutting the optical fiber occurs during negative blade speed? How can a blade have negative thickness (say -1) to come up with a blade speed of 318 mm/min? What happens if  $\beta$  is negative? What happens if  $\beta$  is never positive? Does the blade disappears if  $\beta$  never meets the “when” limitation? Does the blade speed starts from a positive speed and decreases to negative speeds as the blade approaches the fiber since  $\beta$  expression is less than equal to  $-253\alpha - 65$ ? What happens to the blade during negative speed? Does speed depends on direction? How does the blade thickness determines or

influences the direction of the blade? Does the blade move towards the fiber when the thickness is 0.257 mm? Does the blade move away from the fiber when the thickness is 1 mm?

Examiner's physics textbook does not use the term "speed" synonymously with the term "velocity". The textbook distinctly gives two different definitions.

NOTE: No art rejections have been applied to the claims 5-16 since there are a great deal of confusion and uncertainty as to the proper interpretation of the limitations of claims.

Therefore, it would not be proper to reject such claims on the basis of prior art. See MPEP 2173.06.

#### ***Response to Arguments***

8. Applicant's arguments filed 12/6/02 have been fully considered but they are not persuasive.

Applicants failed to answer the concerns appear in the Office Actions.

It is evident by questions raised by the Examiner that the disclosure fails to explain how the thickness of the blade determines or influences the direction in which the blade moves. It would seem that the blade speed equation moves the blade away from the fiber for a thicker blade (1 mm), while a thinner blade (0.257 mm) would move toward the fiber. Examiner would like to reiterate to the applicants that Speed is always a positive number (absolute value). Speed does not equal velocity.

#### ***Interviews After Final***

9. **Applicant note that an interview after a final rejection will not be granted unless the intended purpose and content of the interview is presented briefly, in writing (the agenda of the interview must be in writing) to clarify issues for appeal requiring only nominal**

further consideration. Interviews merely to restate arguments of record or to discuss new limitations will be denied. See MPEP 714.13 and 713.09.

*Conclusion*

10. Applicants are duly reminded that a full and proper response to this Office Action that includes any amendment to the claims and specification of the application as originally filed requires that the applicant point out the support for any amendment made to the disclosure, including the claims. See 37 CFR 1.111 and MPEP 2163.06.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rick K. Chang whose telephone number is (703) 308-4784. The examiner can normally be reached on 5:30 AM to 1:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (703) 308-1789. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



**RICHARD CHANG**  
**PRIMARY EXAMINER**

RC

January 23, 2003